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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,927	08/21/2001	Steven O. Markel	577172000600	7741
43997	7590	12/19/2005	EXAMINER	
OPTV/MOFO			BAYERL, RAYMOND J	
C/O MORRISON & FOERSTER LLP			ART UNIT	
1650 TYSONS BOULEVARD, SUITE 300			PAPER NUMBER	
MCLEAN, VA 22102			2173	

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/933,927	MARKEL, STEVEN O.	
	Examiner	Art Unit	
	Raymond J. Bayerl	2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28 - 57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28 - 57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5 sheets</u> . | 6) <input type="checkbox"/> Other: _____ |

1. Appendices A, B, filed 21 August 2001, are objected to under 37 CFR 1.96 (b), as exceeding the limit of 300 lines that is given, for material which applicant would have printed in a patent. See also MPEP 608.05(a). Applicant should consider instead the procedure of 37 CFR 1.96(c), where such program listings can be properly attached as a compact disc appendix.

2. The specification is objected to for containing reference numeral indications that are inconsistent with the drawings.

Page 7, line 26—"528" appears instead to refer to item 512, fig 5; *RB*

Page 7, line 27—"503" (514?);

Page 8, line 1—"522" (520?);

Page 8, line 1—"524" (522?);

Page 8, line 2—"526" (524?);

Page 8, line 3—"528" (526?);

Page 8, line 4—"530" (528?);

Page 8, line 5—"532" (530?);

Page 8, line 6—"534" (532?);

Page 8, line 7—"536" (534?);

Page 8, line 9—"540" (538?);

Page 8, line 9—"542" (540?);

Page 8, line 10—"544" (524?).

Appropriate correction is required.

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3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 29 - 30, 37, 47 - 48, 51, 57 are rejected under 35 USC 112, second paragraph, for failing to particularly point out and distinctly claim what applicant regards as the invention.

Claim 29's "said enhancement file" lacks clear antecedent basis in parent claim 28, which recites "a platform independent enhancement file", "a first output file" and "a second output file", all of which are used for "television enhancement". To expedite prosecution, the Examiner presumes that applicant meant ~~the~~ "platform independent enhancement file". A similar problem exists with respect to claims 30, 37.

RS

In claim 47, "said enhancement file" can take as its antecedent either of "a platform independent enhancement file" or "an output file" in parent claim 46, since the "output file" also produces an "enhancement" when it is used. See also "said enhancement file" in claim 48.

Claim 51 lacks clear antecedent for "said enhancement file", in that parent claim 50 recites "a platform independent enhancement file" and the two examples of "an output", all of which contribute to "television enhancements". Please note the similar problem with "said television enhancement file" in claim 57.

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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6. Claims 42 – 49, 55, 56 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Independent claim 42 recites a “parser...comprising:”, followed by a list of “function” components. However, such a claim, in being directed solely to the “function” capabilities of the “parser”, is an attempt to claim the functionalities as would be found in the computer program *per se* that could be called a “parser”. Such a claim is not properly directed to a “process, machine, manufacture, or composition of matter”, in that there is no tangible embodiment that would provide for a practical technological application.

The “television enhancement produced by the steps of:...” in independent claim 46 is merely a recitation of the data that is produced as a result of the various steps. As in the case of a computer program *per se*, this claim is directed solely to information, and thus does not qualify under the 4 statutory classes of invention.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 28 - 41, 46 - 54, 57 are rejected under 35 USC 103(a), as being unpatentable over Wugofski (“Wugofski”; US #6,201,538 B1) in view of Zigmond et al. (“Zigmond”; US #6,785,902 B1).

As per independent claim 28's "method of creating a television presentation enhancement", Wugofski teaches CONTROLLING THE LAYOUT OF GRAPHICS IN A TELEVISION ENVIRONMENT, by using a graphics layout language that is defined by the broadcaster or the studio to control the layout of graphic overlays in relation to corresponding images (Abstract). This produces TV that is enhanced as seen in figs 3A, 3B, 4A, 5A, 6A, 7A, via a hardware component having a personal computer (PC) mode and a television (TV) mode, with graphics and a video image presented for each mode, respectively (col 2, lines 32 -53).

Specifically notable as to Wugofski, is that by varying the HTML data files, control is provided to the broadcaster over what objects are displayed on the screen, and without re-writing the executables (Abstract). Such HTML data files are exemplified in figs 3C, 4B, 5B, 6B, 7B, in which a TV object combines, for example, with a menu which overlays television video (col 5, line 62 - col 6, line 63), where Each television channel is essentially a web page designed by the broadcaster (col 7, lines 18 - 33). To perform such design, a set of User interface components is held in a generic user interface container, where such containers are themselves embedded in an HTML file which specifies what user interface containers are available (col 7, line 55 - col 8, line 4).

The ability to open pre-existing HTML files for the purpose of adding an "enhancement" in Wugofski suggests "accessing a platform independent enhancement file containing elements, attributes of said elements, and trigger information", used to produce such an effect "in synchrony with at least one image of a video presentation". In then proceeding by varying the HTML data files to present a television channel with

an effect such as a menu, a “parsing script” is applied to the pre-existing Wugofski HTML, so as to generate an “output file” that is used by the hardware in the “rendering of said enhancement”.

Wugofski suggests in particular the “second parsing script” of claim 28, where an “enhancement in synchrony with said at least one image on a specific television platform” is the result of broadcaster HTML control. Wugofski does not **explicitly** disclose that a “first parsing script” is also used, to author “a first output file” to generate the “enhancement” “in synchrony with said at least one image in a web browser having an embedded media player”, since it is only one hardware environment with a television channel display that is supported.

However, Zigmond, in INTEGRATING BROADCAST TELEVISION WITH WEB PAGES, has a different form of Web pages, where a Web-page author can reference a TV station, with the rendered result appearing in the background of an HTML document, in a frame specified by the TV attribute (Abstract; col 2, lines 41 - 53; fig 2). Please note that a TV Frame and a Score Frame are within the Document Data Structure (fig 5), where an HTML document defines the collective HTML image 220 and video image 210 (col 3, lines 23 - 50). To execute the display of broadcast TV, some form of “embedded media player” (see also claims 51, 57) will be used (col 3, lines 38 - 68), along with a “web browser”.

Thus, it would have been obvious to a person having ordinary skill in the art at the time of applicant’s invention that the Wugofski approach of varying the HTML data files derived from a “platform independent” HTML source should have alternative

options of producing its “output file” for “a specific television platform”, as in Wugofski, and for “a web browser having an embedded media player” as in Zigmond, because this allows for a wider variety of output platforms to be usable. Wugofski’s own disclosure suggests as much, in using HTML, but with a “television platform”; the case of an end user having merely “a web browser” would motivate the person having ordinary skill to generate various output files by means of a “parsing script” such as that which accesses and loads from an HTML source, so that the “enhancement” can be created for a user who merely has a “web browser”. This will yield an “output file” that can be displayed “in a browser window” (claim 31).

The “XML compliant tags” in “said enhancement file” in claims 29, 47 reads at least upon Zigmond’s indication that XML was used in the art for describing Web documents (col 1, lines 27 - 50). The HTML that Wugofski uses as a basis “is a text file” as per claim 30 (note, also, the “text” format of Wugofski’s fig 3C).

As per claim 32’s “specifying a version of HTML for said second output file”, Zigmond teaches that authoring complies with HTML Specification 4.0 (col 3, lines 51 - 67), and Wugofski’s similar generation of HTML should therefore have a specification relating to a “version of HTML”, so that it will properly execute. This kind of specification in authoring HTML also typically includes the handling of “project administration” in conjunction with “page layout” and “trigger creation information”, as is seen in both Wugofski and Zigmond (claim 39).

The nature of HTML as in either Wugofski or Zigmond is such that “a link is associated with at least one of said elements” (claim 33), and z-ordered (three-

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dimensional) cascading style sheets in Zigmond (col 5, lines 38 - 57) suggests claim 34's "z order value for at least one of said elements". The cascading style sheets used in Zigmond further suggest "an XSL transformation file" for a "parsing script" (claims 35 - 36, 48), since XSL stands for eXtensible Stylesheet Language.

Because the HTML in Wugofski is varied by the broadcaster to correspond to a particular television platform, the originally-accessed "enhancement file" will have fields that will accomplish a "change text" operation (claims 37, 52, 53), and in opening such HTML, the "second parsing script imports HTML code" that is used for "said second output file" (claim 38).

A principal function of Zigmond is to render transparent HTML image (col 6, lines 19 - 48), so that a final "color value" is brought into being (claims 40, 49, 54), which can extend to the development of HTML by a "second parsing script" in Wugofski, when "editing said platform independent enhancement file" (claim 41) takes place.

Independent claim 46 is similar to claim 28 as treated above, in that an accessed "platform independent enhancement file" such as is opened in Wugofski by a "parsing program" is made into "an output file". The use of "a plurality of parsing programs" is then suggested by Zigmond's disclosure of a second form of "specific platform", to produce the "television enhancement" as claimed.

Independent claim 50's joint use of "a first" and "second parser" for a "browser" and "television platform", respectively, reads upon Wugofski's extension to plural platform support, as suggested by Zigmond.

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9. Claims 42 - 45, 55 - 56 are allowable over the prior art now made of record, but applicant still needs to address the difficulty that remains with these claims under 35 USC 101, with their reading upon a "parser" that is a computer program *per se*, as noted above.

As per independent claim 42, a variety of "television enhancement" effects, such as those for "a text element or a graphic element" or "a television element", may be generated to be "platform specific" from "a platform independent file" in the Wugofski and Zigmond disclosures. Such a combination will create "an HTML header", and will typically have the capacity to "insert JavaScript code" (Wugofski) and operate "a media player" (Zigmond). But neither this nor the remaining prior art now made of record teaches that such a procedure "places said position of said element between division tags in an HTML output file", that the "JavaScript code" is inserted "if said element is an imported element" and that "triggers in a JavaScript array" are produced. While a "parser" *per se* is taught to produce a "platform specific television enhancement" in the Wugofski/Zigmond combination, the level of detail in claim 42 is not fairly seen.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The remaining US Patent documents made of record (see attached form PTO-892) relate to applicant's topic of producing an enhanced television presentation.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond J. Bayerl whose telephone number is (571)

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272-4045. The examiner can normally be reached on M - Th from 9:00 AM to 4:00 PM ET.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (571) 272-4048. All patent application related correspondence transmitted by FAX **must be directed** to the central FAX number (571) 273-8300.

13. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.



RAYMOND J. BAYERL
PRIMARY EXAMINER
ART UNIT 2173
12 December 2005